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APR 25 2005

OFFICE OF PETITIONS

In re Application of :
Wen-Hwa Lee, Huei-Jen Su Huang, Eva: :
Y.H.P. Lee, Theodore Friedmann, and: DECISION ON PETITIONS
Jiing-Kuan Yee :
Application No. 10/028,726 :
Filed: December 21, 2001 :
Attorney Docket No. 20350 :

This is a decision on the "COMMUNICATION IN RESPONSE TO DECISION ON PETITION UNDER 37 CFR 1.48(a)", filed February 10, 2005, which is also being treated as a petition under 37 CFR 1.183 to waive the requirement of 37 CFR 1.48(a)(3).

The petition under 37 CFR 1.183 is GRANTED.

The petition under 37 CFR 1.48(a) is GRANTED.

The above-identified application was filed on December 21, 2001 with a declaration executed by Wen-Hwa Lee, Huei-Jen Su Huang, and Eva Y.H.P. Lee as joint inventors. On July 19, 2004, a petition under 37 CFR 1.48(a) was filed to amend the inventorship to add joint inventors Theodore Friedman Jiing-Kuan Yee. The petition was treated as a petition under 37 CFR 1.183 to waive the requirement of 37 CFR 1.48(a)(3) and dismissed in a decision mailed on November 24, 2004. Petitioner did not supply a 37 CFR 3.73(b) statement to demonstrate consent of the assignee.

37 CFR 1.48(a) requires:

- (1) A request to correct the inventorship that sets forth the desired inventorship change;
- (2) A statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;
- (3) An oath or declaration by the actual inventor or inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43 or § 1.47;
- (4) The processing fee set forth in § 1.17(i); and
- (5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

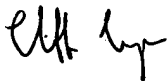
Petitioner has satisfied requirements (1), (2), (4) and (5) above. The petition specifically requests the addition of inventors Friedman and Yee. Petitioner has included the required statements from Friedman and Yee. Petitioner has paid the processing fee. Finally, the petition includes a statement signed by Patricia Anderson Cotton, Director of assignee The Regents of the University of California.

However, petitioner has not submitted a 37 CFR 1.63 declaration executed by all of the inventors as required by 37 CFR 1.48(a)(3). The 37 CFR 1.63 declaration was not executed by inventors Lee, Huang, and Lee. In order for a petition under 37 CFR 1.183 to be granted, petitioner must demonstrate that this is an extraordinary situation where justice requires waiver of the rules. In the "Declaration to Support Petition Under 37 CFR 1.48(a)", petitioner attested that copies of the corrected declaration were forwarded to Lee, Huang, and Lee. Inventors Lee and Lee made an oral refusal to sign the declaration during a telephone conversation with petitioner. The corrected declaration was received by Huang (as evidenced by Federal Express tracking receipts), but never returned.

Accordingly, the newly executed declaration filed on July 19, 2004 will be entered, despite the fact that the requirement set forth in 37 CFR 1.48(a)(3) that all the inventors sign a reexecuted oath or declaration has not been satisfied.

The application file is being forwarded to Group Art Unit 1632 for examination in due course.

Telephone inquiries related to this decision may be directed to the undersigned at (571)272-3207.



Cliff Congo
Petitions Attorney
Office of Petitions